

REMARKS

Claims 1-38 are pending in the above-identified application. Claims 39-61 were withdrawn from consideration. Claims 1-38 were rejected. With this Amendment, claims 14-19, 21, 23, 24, 28-33, 35, 37, and 38 were amended, and claims 62-67 were added. Accordingly, claims 1-38 and 62-67 are at issue in the above-identified application.

I. 35 U.S.C. § 112 Indefiniteness Rejection of Claims

Claims 14 and 28 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant respectfully traverses this rejection.

Applicant has amended claims 14 and 28 to provide an antecedent basis for “the release paper.” Applicant has also amended claims 15-19, 21, 23, 24, 29-33, 35, 37, and 38 to provide similar antecedent bases. Accordingly, Applicant respectfully requests withdrawal of this rejection.

II. 35 U.S.C. § 102 Anticipation Rejection of Claims

Claims 1-5, 7-10 were rejected under 35 U.S.C. § 102(b) as being unpatentable over U.S. Patent No. 5,262,215 to Shields. Applicant respectfully traverses this rejection.

Claim 1 is directed to a decal sheet comprising an image on a surface, release paper on the surface over the image, an adhesive layer on the release paper, a base layer on the adhesive layer, and another image on the base layer. The image has a shape. The adhesive layer and the base layer are formed in a shape similar to the image shape. The other image is identical to the image, and the image and the other image coincide.

Shields is directed to a laminated article for having separable pieces for detachable placement on a background. The laminated article includes a web releasably adhered to a carrier sheet having indicia imprinted thereon. (See Abstract). The web includes a die cut top layer having indicia-imprinted separable pieces releasably adhered to a support layer. (See Abstract). Upon separating the web from the carrier sheet, selected ones of the separable pieces can be releasably attached to the carrier whereby the respective indicia cooperate for the playing of a game or creation of a scene. (See Abstract). For example, as depicted in Figure 4, the web comprises humorous facial features for cooperative placement on the corresponding facial outline seen as the indicia imprinted on the carrier sheet 14. (See column 2, lines 11-15). Thus, in Shields, the indicia imprinted on the top surface 24 is not identical to the indicia imprinted on the carrier sheet. Contrary to claim 1, Shields neither discloses nor suggests an image identical to the other image. Moreover, Shields neither discloses nor suggests the adhesive layer and the base layer formed in a shape similar to the image shape on the surface, as required by claim 1. Because claim 1 includes limitations that are neither disclosed nor suggested by Shields, claim 1, and claims 2-5 and 7-10 that depend from claim 1, are allowable over Shields. Accordingly, Applicant respectfully requests withdrawal of this rejection.

III. 35 U.S.C. § 103 Obviousness Rejection of Claims

Claims 6 and 11-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,262,215 to Shields in view of U.S. Patent No. 6,110,317 to Sandor. Applicant respectfully traverses this rejection.

As discussed above, claim 1 includes limitations that are neither disclosed nor suggested by Shields. Thus, it would not be obvious to one of ordinary skill in the art to modify the

laminated article of Shields with the teachings of Sandor to derive claims 6 and 11-12. Accordingly, Applicant respectfully requests withdrawal of this rejection.


Claims 13-38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,262,215 to Shields in view of U.S. Patent No. 6,110,317 to Sandor.

For reasons similar to those discussed above with regard to Claim 1, Applicant respectfully submits that independent Claims 13 and 25 are also allowable over Shields in view of Sandor. Additionally, Claims 14-24 and 26-38, which ultimately depend from claims 13 and 25, respectively, are also allowable by virtue of their respective dependencies from allowable independent claims. Accordingly, Applicant respectfully requests withdrawal of this rejection.

In view of the above amendments and remarks, Applicant submits that all claims are clearly allowable over the cited prior art, and respectfully requests early and favorable notification to that effect.

Respectfully submitted,

Dated: December 3, 2003

By: 
Marina N. Saito
Registration No. 42,121
SONNENSCHN NATH & ROSENTHAL
P.O. Box 061080
Wacker Drive Station, Sears Tower
Chicago, Illinois 60606-1080
(312) 876-8000